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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/110,667	07/07/1998	PETER C. BOYLAN III	UV-76	4967

7590 05/20/2005

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EXAMINER
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HUYNH, SON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/110,667

Applicant(s)

BOYLAN III ET AL.

Examiner

Son P. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 133-136 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 133-136 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/25/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/25/2005 has been entered.

### ***Response to Arguments***

2. Applicant argues the combination of Alexander and Kikinis does not disclose displaying, on at least a portion of the television program guide display screen, a local advertisement that has been designated for display in the particular geographic region of the user television equipment and that distinct from but corresponds to the global advertisement selected by the user (page 11, paragraph 2, lines 1-7).

In response, the examiner respectfully disagrees. The claim recites 'means for displaying, on at least a portion of the television program guide display screen, a local advertisement that is designated for display in the particular geographic region of the user television equipment and that is distinct from but corresponds to the global

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advertisement selected by the user in response to receiving the user selection" is met by displaying on the screen of the television program guide screen, a customized message of advertisement that is designated for display in the particular zip code of viewer equipment during television program or video clip or selected theme Guide, the customized message (e.g. Burger King in the viewer's local area, Goodyear Tires (in the viewer's local area)) that is distinct from (e.g. television program, Sport theme guide, video clip) but display in response to user selection of the television program or displayed during, theme guide, video clip (see Alexander, col. 32, line 35-col. 34, line 25).

For reason given above, rejections on claims 133-136 are discussed below.

Claims 1-132 have been cancelled.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 133-136 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US 6,177,931).

Regarding claim 133, Alexander discloses a system for providing television programs that comprises advertisements, program guide information of television programs, and customized messages of advertisements based on the viewer zip code from various sources such as Internet or head end (col. 8, lines 18-64). The customized information of the customized messages is embedded in the advertisement video streams (col. 32, lines 35-60). The customized messages are displayed on the program guide based upon the content of the television program, based upon the theme/category Guides (col. 33, line 30-col. 34, line 25). Alexander further discloses an interactive program guide for displaying advertisements such as a video clip of a television program being advertised in ad window and various theme Guides, e.g., Sports, Movies, News, etc. in the Grid Guide (col. 7, lines 45-56; col. 19, line 50-col. 20, lines 12; figures 7-8).

Alexander also discloses ad windows are interactive, and the viewer can select advertisements such as a video clip on the ad windows (col. 13, lines 47-55; col. 17, line 40-col. 18, line 67). The customized messages of advertisements run during a television program or in a video clip in the Ad windows (col. 32, lines 45-60). Thus, the claimed system in which local and global advertisements are distributed to user television equipment on which an interactive television program guide is implemented is met by Alexander's disclosure wherein the global advertisement is broadly either met by advertisement such as video clip of program displayed in Ad windows or theme Guide

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such as News, Sports, etc. in the interactive program guide and the local advertisement is broadly met by customized messages of advertisements designated in a particular zip code and based upon video clips, program, theme guides. With the interpretation of global and local advertisements above, the claimed system is met by Alexander's disclosure as follow:

"means for distributing global and local advertisements to the user television equipment, wherein the local advertisements are designated for display in a particular geographic region" is met by sources such as head end or internet for distributing television programs, video clips or theme Guides and customized messages of advertisements to the viewer equipment, wherein the customized messages of advertisements are designated for display in a particular zip code (e.g., message to advertise Burger Kings in the viewer local area – col. 32, lines 42-47);

"means for displaying an interactive television program guide display screen" is met by display for displaying interactive program guide display screen 10 (figure 8);

"means for using the interactive television program guide to display the global advertisement on the television program guide display screen" is broadly met by Ad windows or Theme guide icons, television program icons for displaying television programs, video clips, theme Guides on the interactive television program guide display screen (figure 8);

"means for receiving a user selection of the global advertisement" is broadly met by viewer's remote control for receiving viewer selection of a television program, video clip in Ad window or Theme Guide on the interactive program guide (figure 2); and

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'means for displaying, on at least a portion of the television program guide display screen, a local advertisement that is designated for display in the particular geographic region of the user television equipment and that is distinct from but corresponds to the global advertisement selected by the user in response to receiving the user selection" is met by displaying on the screen of the television program guide screen, a customized message of advertisement that is designated for display in the particular zip code of viewer equipment during television program or video clip or selected theme Guide, the customized message (e.g. Burger King in the viewer's local area, Goodyear Tires (in the viewer's local area)) that is distinct from (e.g. television program, Sport theme guide, video clip) but display in response to user selection of the television program or displayed during, theme guide, video clip (col. 32, line 35-col. 34, line 25).

Regarding claim 134, the limitations of the method being claimed respectively correspond to the limitations of the system being claimed in claim 133 and are analyzed as discussed with respect to the rejections of claim 133.

Regarding claim 135, the limitations being claimed correspond to the limitations being claimed in claim 133 and are analyzed as discussed with respect to the rejection of claim 133.

Regarding claim 136, the limitations of the claims are respectively directed toward embody the method of claim 133 in a "machine readable medium." Alexander further

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discloses instructions to perform functions of the viewer equipment are controlled by a processor (col. 5, lines 20-52). Inherently, Alexander discloses a "machine readable medium" for use in a system so that a processor could automatically perform the instructions.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morales (US 5,663,757) teaches software controlled multi mode interactive TV system. Zigmond et al. (US 6,400,407) teaches communicating logical address of resources in a data service channel of a video signal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SPH  
May 10, 2005

A handwritten signature in black ink, appearing to read "Chris Grant", with a stylized flourish at the end.

CHRIS GRANT  
PRIMARY EXAMINER